

REMARKS

- Claims 1 – 29, 31 – 43, 45 – 104, 106, 107, and 109 are currently pending in the present application.
- Of the currently pending claims, only claims 1, 38, 39, 41 – 43, 45, 46, 97, 101 – 104, 106, and 109 are independent.
- Applicants thank Examiner for extending the courtesy of a telephone interview on July 22, 2003. During the interview, Applicants argued that Garfinkle does not teach the claimed feature (e.g., claim 1) of providing a payment to a retailer, where the payment is not based on the price that the buyer agreed to pay. Although no agreement was reached, Examiner agreed to take this argument into consideration once a formal Response and RCE were filed. Applicants appreciate the opportunity to verbally present the argument to Examiner.

I. RCE

This response is being filed in response to a Final Office Action. Accordingly, a Request for Continuing Examination has been filed herewith, in compliance with 37 C.F.R. §1.114.

II. Double Patenting

Each of the pending claims 1 – 29, 31 – 43, 45 – 104, 106, 107, and 109 stand provisionally rejected under the judicially created doctrine of double patenting over the claims and specification of co-pending Application No. 09/337,906. (¶2, pg. 2 of paper no. 10).

Since the scope of the claims of this Application and the co-pending Application have not yet been determined, Applicants are refraining from filing a terminal disclaimer at this time. Applicants thank Examiner for informing Applicants of Examiner's intention to assert a double patenting rejection.

III. Section 103 Rejections

A. Claims 1 – 15, 18 – 29, 38 – 43, and 45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,085,168 to Mori (“Mori” herein) in view of U.S. Patent No. 6,512,570 B2 to Garfinkle et al. (“Garfinkle” herein). Applicants respectfully traverse the rejection of these claims, for the reasons set forth below.

Claims 1, 38, 39, 41, 42, 43, and 45 (the only independent claims from this set of rejected claims) each recite the following feature, which is not taught or suggested by either Mori or Garfinkle, alone or in combination:

“wherein the payment [that is provided from the purchasing system in exchange for providing the product to the buyer] is based on a first price of the product agreed upon between a retailer and the purchasing system and *not on a second price of the product that the buyer agreed to pay*”
(emphasis added)

In other words, the payment that is provided from the purchasing system is not based on the price that the buyer agreed to pay for the product. Examiner relies on Garfinkle as allegedly teaching the above-recited feature and points to col. 11, lines 1 – 20 in support of this alleged teaching. Upon review of this passage (as well as the remainder) of Garfinkle, Applicants respectfully disagree that the above-recited feature is taught or suggested. The cited passage merely describes that various parties may receive different portions of the price that a buyer in Garfinkle pays for a product. “The disbursement sheet identifies how profits obtained from *the orders* are shared between the developer 12, the scanning center 14, the fulfillment center 20, and any other party.” (emphasis added) Since the orders are order for products where the buyers agree to pay the price listed on a price sheet displayed to the buyers, the profits from the orders are payments necessarily based on the price the buyers agree to pay. Again, in the claimed embodiments, it is specifically recited that the payment provided to a retailer is not based on the price for the product that the buyer agrees to pay.

Examiner has asserted that Garfinkle teaches that “the money generated from a sale is dispersed according to a method agreed upon before hand between a third party

and a retailer (col 11, lines 1 – 20). It would be obvious to a person of ordinary skill in the art to include in Mori arriving at a second price agreed to ahead of time between the third party and the retailer that is different from the price agreed to between the buyer and the third party, because this would assure that the retailer would be willing to accept an amount lower than agreed to between the buyer and third party seller and provide for a smoother transaction when the product is picked up.” (bottom of page 4 – top of page 5 of paper no. 15). Applicants respectfully disagree with this assertion for a variety of reasons.

First, Applicants respectfully point out that the claimed feature does not claim that the payment provided by the purchasing system is different from the price the buyer agrees to pay. Rather, the claimed feature recites that the payment provided by the purchasing system is not based on the price the buyer agrees to pay. Thus, the payment provided by the purchasing system is in an amount that is not dependent on and is irrespective of the price that the buyer agrees to pay. In Garfinkle, the payments that are distributed are based on the price that the buyer agrees to pay for the product, since they are a portion of the price.

Second, Applicants respectfully disagree that it would have been obvious to one of ordinary skill in the art, at the time of Applicant’s invention, to include in Mori a feature where a retailer enters into an agreement to accept a price that is lower than the price of a product that a buyer agrees to pay. Mori discloses a system wherein a financial institution freezes funds in the amount of a purchase total, at the request of a purchaser, and informs the seller of the guaranteed available funds to reassure the seller that the purchaser has and will have sufficient funds to pay for the purchase. Once the purchaser obtains the product, the financial institution releases the funds to the seller. The point of Mori is to reassure the seller that the entire purchase total will be paid. Mori discloses an agreement between the purchaser and the financial institution but does not disclose any agreements, other than for a particular transaction, between the seller and the financial institution. Other than ensuring that the purchaser has sufficient funds to pay the purchase total, the financial institution is not involved in the particulars of a transaction. The price for the product(s) being purchased in Mori is established between the seller and

the purchaser directly, and the financial institution is simply informed of the agreed upon purchase total after it is established. It does not make sense for the seller in Mori to agree to accept a payment in an amount less than what the purchaser agreed to pay for the product, since the purchaser agrees to the price directly with the seller and then simply informs the financial institution of that agreed upon price so that the appropriate amount of funds can be frozen. In fact, the main point of Mori is to assure the retailer, by means of the funds frozen by the financial institution, that the retailer will receive a payment in the full amount that the purchaser agreed to pay when entering into the agreement to purchase the product. Therefore, Applicants disagree that it would have been obvious to incorporate the claimed feature, or the feature described by Examiner, in Mori.

Finally, even if Mori and Garfinkle taught what Examiner relies upon them for (which Applicants respectfully submit they do not), Applicants respectfully submit that Examiner has not met his burden of establishing a *prima facie* case of obviousness, in that Examiner has not articulated a motivation to combine these references. Establishing a motivation to combine references consists of pointing to a particular teaching in the references themselves or otherwise in the record that, if read by one of ordinary skill in the art at the time of Applicants' invention and without first reading Applicants' disclosure, would have motivated the one of ordinary skill in the art to combine the references in a manner that would have results in Applicants' claimed invention. Examiner has merely provided a conclusory statement about an alleged beneficial result that may be realized from the combination of references, without providing any reasoning of what teaching in the references or otherwise in the record would have motivated one of ordinary skill in the art to make the suggested combination. If Examiner maintains this §103 rejection, Applicants respectfully request that Examiner articulate a reasoned motivation to combine the references that satisfies the Examiner's burden of establishing a *prima facie* case of obviousness.

See MPEP 2142:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

In summary, Garfinkle does not teach or suggest a feature recited in independent claims **1, 38, 39, 41, 42, 43, and 45**. Mori also does not teach or suggest the above-recited feature, as Applicants argued in detail in the response to the previous Office Action and as Examiner admitted in the response. Since neither Garfinkle nor Mori, alone or in combination, teach or suggest each of the limitations of the pending independent claims **1, 38, 39, 41, 42, 43, and 45**, these claims are patentable over the

combination of Garfinkle and Mori. The dependent rejected claims **2 – 15** (dependent from claim 1), **18 – 29** (dependent from claim 1), and **40** (dependent from claim 39) are also patentable over the combination of Garfinkle and Mori because they each include the above-recited feature, by virtue of being dependent from an independent claim that recites the feature.

B. Claims 16, 31 – 37, 101, and 106 – 107 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mori, in view of U.S. Patent No. 5,924,080 to Johnson (“Johnson” herein). Applicants respectfully traverse the rejection of these claims, for the reasons set forth below.

Independent claims **101 and 106** (the only independent claims of this set of rejected claims) each recites the following feature, which is not taught or suggested by Mori or Johnson, alone or in combination:

providing to (at least one of (claim 106)) a retailer (and the delivery service (claim 106))... a second price, wherein the second price is a price agreed upon between an operator of the purchasing system and at least one of the retailer and (an operator of the delivery service (claim 106) or the seller (claim 101)) and *is not based on the first price defined by the buyer*” (emphasis added)

First, Applicants note that although claims **101 and 106** are listed as being rejected over a combination of Mori and Johnson (middle of pg. 12 of paper no. 15), in support of the rejection of claims **101 and 106**, respectively, Examiner appears to solely be relying on Mori (see, pg. 14 – top of pg. 15 of paper no. 15). Second, Applicants further note that in support of the rejection of claims **101 and 106**, respectively, Examiner asserts that Mori teaches the above-recited claim feature. This assertion appears to be in direct contrast to Examiner’s admission on page 4, where Examiner states that Mori “does not specifically mention that the payment is based on a first price of the product agreed upon between a retailer and the party different from the buyer”. That statement was made in the context of providing support for the rejection of claim **1**, where Examiner asserted that Garfinkle, and not Mori, taught a feature similar to the

above-recited claim feature. Because of these ambiguities in the reasoning supporting the rejection of claims **101 and 106**, Applicants are unclear as to which reference Examiner is relying on as teaching each particular claimed feature of claims **101 and 106**.

Despite the apparent ambiguities in the support for the rejection of claims **101 and 106**, Applicants have reviewed each of Mori, Garfinkle, and Johnson and conclude that none of these references, alone or in combination, teaches or suggests the above-recited claim feature. The detailed explanation of why neither Mori nor Garfinkle, alone or in combination, teaches or suggests the above-recited claim feature was provided in the traversal of the rejection of claim **1**, and need not be repeated since it is equally applicable to the traversal of the rejection of claims **101 and 106**, respectively. Johnson also does not teach or suggest the above-recited claim feature. Johnson discloses a system for applying discounts to products purchased at a retailer, without the need for paper coupons. Johnson does not disclose a payment being provided to a retailer. In fact, Johnson explicitly teaches away from providing a payment to the retailer: “The use of the instant system eliminates ...the need for the manufacturer to pay the grocery store for the coupons...” (col. 5, lines 32 – 37). However, even if Johnson did disclose a payment being provided to a retailer, such a payment would be for an amount of the discount provided to the buyer, which necessarily is based on the price for the product that the buyer pays.

Applicants also dispute Examiner’s assertion that Mori teaches the following feature of claim **101**:

the same entity that receives a buyer offer and provides a payment to a retailer also performs the step of:

“selecting at least one retailer from a plurality of retailers”

Mori teaches that a purchaser transmits a purchase request to the purchaser’s financial institution for a purchase amount. Before transmitting the purchase request to the financial institution, the purchaser agrees with a particular seller on the purchase of a product or service. Thus, the purchase request may identify the seller. (for example, col. 16, line 66 – col. 17, line 15). Other than from the purchase request, the financial

institution does not identify the seller of the proposed purchase. In other words, although a plurality of retailers may participate in the Mori system, the financial institution in Mori does not select the retailer from a plurality of retailers. Rather, the purchaser selects a seller and identifies that seller to the financial institution. In contrast, in Applicants' claimed embodiments, the same entity that receives the buyer offer, including the buyer offer price, also selects a retailer from a plurality of retailers and provides a payment to a retailer. Such a feature is not taught or suggested by Mori, nor by any other prior art of record.

Further, Applicants respectfully disagree that Johnson comprises analogous art that was properly included in a §103 rejection of the pending claims. Johnson addresses a different problem and relates to a different field than Applicants' claimed embodiments. Johnson relates to the coupon field, and addresses the problem of making coupon redemption more efficient. It does not relate to the retail purchasing field, where customers establish a price for a product through a communication network and take possession of the product at a retailer.

Applicants note that Examiner did not provide any motivation to combine Mori and Johnson (*i.e.*, teachings in the references that would have motivated one of ordinary skill in the art to make the suggested combination). Examiner merely stated a result that may be realized by combining the two references which, as discussed above, is insufficient to establish a motivation to combine the references. Accordingly, Applicants respectfully submit that the §103 rejections based on the combination of Mori and Johnson is not proper because Examiner has not met his burden of establishing a case of motivation to combine. If Examiner maintains the rejection of any of the claims based on the combination of Mori and Johnson, Applicants respectfully request that Examiner provide a proper motivation to combine the two references.

Regarding claims **16 and 17**, Applicants also respectfully disagree with Examiner's assertion that Johnson discloses supplemental offer information being included in redemption information for a product. In Johnson, a plurality of discounts for a variety of products may be available to a customer, via a consumer membership card, when the customer brings products to a register. Each discount is associated with a

particular product. Other than a distinct discount being associated with a distinct product, Johnson does not disclose any *supplemental* offer information being associated with a distinct product or distinct discount. In Applicants' claimed embodiments, redemption information for a distinct product also has associated therewith supplemental offer information. For example, if a customer established a price for a VCR through a communication network, the redemption information will identify the VCR. Additionally, the redemption information may include supplemental offer information, such as free tapes to go with the VCR. See example on pg. 13, lines 17 – 21 of specification. Thus, the supplemental offer information is for a product or service supplemental to the product the redemption information is for. In other words, for an offer to be supplemental, there must be a primary product or service for it to be supplemental to. Johnson does not teach such a feature. Each distinct discount available via the membership card in Johnson is associated with a particular product and no supplemental offer information is associated with any of the discounts.

Further, in addition to Applicants position that the Examiner's statement of why it would be obvious to combine Johnson and Mori as being an insufficient reason for a motivation to combine, Applicants respectfully disagree with Examiner's conclusory statement that it would be obvious to "include in Mori the supplemental price information as taught by Johnson because, the supplemental offer could bring the final sales price in line with the consumers expected sale price and cause sales to increase." (bottom of page 12 of paper no. 15). Incidentally, Applicants note that claim 16 recites that the supplemental information comprises supplemental *offer* information and not supplemental *price* information as stated by Examiner. Regardless, Johnson does not teach including supplemental offer information and, even if Johnson did teach such a feature, it would not be obvious to include such a feature in Mori.

Incorporating the feature of supplemental offer information as part of redemption information into Mori would not have been obvious to one of ordinary skill in the art because it does not make sense to have the entity that provides the redemption information in Mori perform such an additional function and the systems and methods of Mori do not enable or make feasible such an additional function. In Mori, the entity that

provides a payment to a retailer is the financial institution of the purchaser. That financial institution only acts on the instructions of the purchaser to freeze funds and then subsequently release funds (with perhaps additional instructions required from the retailer in some embodiments before funds are released). Other than acting on these instructions to insure that the purchaser has sufficient funds to pay for a purchase, the financial institution is not involved in the transaction. The financial institution has no motivation to provide supplemental offers to the purchaser and, since the financial institution is acting on instructions of the purchaser, it does not make sense for the financial institution to provide supplemental offers to the purchaser (since the supplemental offers would have to be made based on instructions of the purchaser). The objective of the Mori system is to reassure a retailer that a purchaser has sufficient funds to pay for a purchase, and will have such funds available when it comes time to pay for the purchase. The function of the financial institution in Mori, the entity that provides the payment to the retailer, is simply to check that such funds are available, to freeze such funds temporarily, and to release such funds upon receiving the appropriate instructions to do so.

The financial institution is not trying to sell anything to the purchaser or acting on behalf of any other entity that is trying to sell something to the purchaser. Rather, the financial institution in Mori is acting on behalf of the purchaser to aid the purchaser in assuring the retailer that the purchaser will pay for the goods and in aiding the purchaser in not paying the retailer if the goods or services end up somehow being defective. Thus, again, it makes no sense to have the financial institution in Mori provide supplemental offers along with redemption information. Importantly, Mori does not enable any system or method for how such supplemental offers might be presented, who would provide such supplemental offers, or how such supplemental offers might otherwise be handled. Thus, not only does it not make sense for supplemental offers to be included in the redemption information of Mori, but such a features is incompatible with the systems and methods disclosed in Mori.

Claims **16 and 31 – 37** are dependent from claim **1**, and thus include the same features as claim **1**. Accordingly, Applicants respectfully submit that claims **16 and 31 –**

37 are patentable at least for the same reasons as discussed with respect to the rejection of claim 1, above.

Claim 107 is dependent from claim 106, and thus includes the same features as claim 106. Accordingly, Applicants respectfully submit that claim 107 is patentable at least for the same reasons as claim 106.

C. Claims 46 – 52, 102 – 104, and 109 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,266,651 to Woolston (“Woolston” herein) in view of Garfinkle. Applicants respectfully traverse the rejection of these claims, for the reasons set forth below.

Independent claims 46, 102, 103, 104, and 109 (the only independent claims in this set of rejected claims) each recite the following feature, which is not taught or suggested by Woolston or Garfinkle, alone or in combination:

“wherein the third price [that is provided to a retailer for the product once the buyer takes possession of the product at the retailer] is a price for the product agreed upon between the retailer and the seller and is not based on the first price that the buyer agreed to pay for the product”

In Woolston, the only disclosed payment that a consignment shop can receive is a portion of the sale price of the collectible (the price for the collectible that a purchaser of the collectible agrees to pay), as a commission fee for selling the item. Thus, the fee to the consignment shop is based on the first price that the buyer agreed to pay for the product. This is unlike, the claimed feature, in which it is explicitly recited that the price provided to the retailer is not based on the first price that the buyer agreed to pay for the product. As already discussed above, Garfinkle also does not teach or suggest providing a payment to the retailer that is not based on a price that the buyer agreed to pay. Since neither Woolston nor Garfinkle teach all of the claimed features of claims 46, 102, 103, 104, and 109, respectively, Applicants respectfully request that this rejection be withdrawn.

Claims 47 – 52 are dependent from claim 46, and thus include each of the features of claim 46. Accordingly, claims 47 – 52 are each patentable at least for the same reasons as discussed with respect to the rejection of claim 46.

D. Claims 54 – 61, 63 – 66, 71 – 78, and 83 – 100 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Woolston, in view of Garfinkle, and further in view of Mori. Applicants respectfully traverse the rejection of these claims, for the reasons set forth below.

Claims 54 – 61, 63 – 66, 71 – 78, and 83 – 100 are each dependent from claim 46, and thus include each of the features of claim 46. Accordingly, Applicants respectfully submit that claims 54 – 61 are patentable at least for the same reasons as discussed with respect to the rejection of claim 46. Regarding claims 60 and 61 in particular, Applicants maintain the position that neither Mori nor Woolston discloses redemption information comprising penalty information (see section IV herein, below). Regarding claims 63 and 64 in particular, Applicants maintain the position that neither Mori nor Woolston discloses redemption information comprising information associated with a plurality of retailers (see section IV herein, below). Regarding claims 65 and 66 in particular, Applicants maintain the position that neither Mori nor Woolston discloses redemption information comprising a plurality of identifiers for a product, each identifier being associated with a different retailer (see section IV herein, below).

E. Claims 53 and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Woolston in view of U.S. Patent No. 6,205,435 B1 to Biffar. Applicants respectfully traverse the rejection of these claims, for the reasons set forth below.

Claims 53 and 62 are each dependent from claim 46 and thus include each of the features of claim 46. Accordingly, Applicants respectfully submit that claims 53 and 62

are each patentable at least for the same reasons as set forth with respect to the rejection of claim 46, above.

Applicants note that this §103 rejection is not proper because no proper motivation to combine the two references (such as particular teachings in the references themselves and a reasoned analysis of why a person of ordinary skill in the art, at the time of the invention, would have been motivated to make the suggested combination) was provided. Examiner, again, merely provided a conclusory statement of a result that may allegedly be realized from the combination, which does not meet the Examiner's burden of establishing a prima facie case of obviousness. If Examiner continues to rely on the combination of Woolston and Biffar, Applicants respectfully request that Examiner provide a proper motivation to combine analysis that satisfies the legal standard set out above.

F. Claims 67 – 70, and 79 – 82 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Woolston, in view of Garfinkle, in view of Mori, and further in view of Johnson. Applicants respectfully traverse the rejection of these claims, for the reasons set forth below.

Claims 67 – 70 and 79 – 82 are each dependent from claim 46 and thus include each of the features of claim 46. Accordingly, Applicants respectfully submit that claims 67 – 70 and 79 – 82 are each patentable at least for the same reasons as discussed with respect to the rejection of claim 46, above.

Regarding claims 67 – 70, in addition to the reasons discussed with respect to claim 46, Applicants maintain that Johnson does not teach supplemental offer information being included in the redemption information (see arguments above regarding claims 16 and 17). Johnson certainly does not disclose that redemption information for a primary product or service is sent to a first retailer while verification information enabling a second retailer to authorize the buyer to take possession of a supplemental product (*i.e.*, supplemental to the primary product or service) is sent to a second retailer.

IV. Applicants' Reply to Examiner's Response to Arguments

In response to the previous Office Action (paper no. 10) applicants argued that Mori does not teach the following features:

- regarding claims 9 and 10, Applicants argued that Mori does not teach or suggest redemption information comprising “penalty information” (section III.B.1, pg. 12 of Response to Paper No. 10)
- regarding claims 13 – 15, Applicants argued that Mori does not teach or suggest redemption information comprising “information associated with a plurality of retailers” (section III.B.2, pg. 13 of Response to Paper No. 10)
- regarding claim 14, Applicants argued that Mori does not teach or suggest redemption information comprising “a plurality of identifiers for a product, each identifier being associated with a different retailer” (section III.B.2, pg. 13 of Response to Paper No. 10)
- regarding claims 60 and 61, Applicants argued that Woolston does not teach or suggest applying a penalty to a party, much less including penalty information in any redemption information (section IV.B.1, pg. 15 of Response to Paper No. 10)
- regarding claims 64 – 66, Applicants argued that Woolston does not teach or suggest redemption information comprising “information associated with a plurality of retailers” (section IV.B.2 of Response to Paper No. 10)

The following are Applicants' replies to Examiner responses to each of the above arguments:

Regarding claims 9 and 10, Examiner responded that “the features upon which applicant relies (i.e., redemption information is associated with more than one seller, and that more that [sic] one product identifier may be associated for a particular

product) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.” (pg. 26 of paper no. 15). Applicants did not assert that either claim 9 or claim 10 recited that redemption information is associated with more than one seller and that more than one product identifier may be associated with a particular product. Rather, for claims 9 and 10, Applicants argued that claims 9 and 10 recited that redemption information comprises penalty information, which the claims do in fact recite, and that such a feature is not taught or suggested by Mori. Since Examiner did not respond to this argument in a meaningful manner, Applicants respectfully request that Examiner do so if Examiner continues to reject these claims based on Mori.

In the current Office Action, Examiner asserts that Mori teaches redemption information comprising penalty information at col. 86, lines 23 – 67. This passage of Mori does not teach penalty information at all, much less such penalty information included in redemption information. Rather, this passage of Mori teaches that, if a seller of goods fails to deliver or otherwise provide the goods in a satisfactory manner, the initial freezing of the funds that were to pay for the goods may be cancelled, such that the funds are now available to the purchaser for other purposes. No penalty information is disclosed. Further, such a cancellation instruction is not part of or comprising redemption information, as in the claimed embodiments, but is a separate subroutine that is carried out.

Regarding claims 13 – 15, Examiner “directs the applicants to columns 2 and 3, where and [sic] object item (transaction associated with the purchase of goods and services) is redeemed. The object is associated with multiple retail services such as nursing, while ant exterminating, and field work cleaning of carpets, etc.” (pg. 26 of paper no. 15). This assertion is a mischaracterization of what this passage of Mori discloses. Applicants respectfully disagree that this passage of Mori teaches redemption information comprising a plurality of retailers. This passage of Mori merely states that provisional settlement information is settled “upon receipt of the confirmation notification that object item has been executed. Therefore, an object item (providing goods, services, etc.) can be executed without depending on a payer’s personal credit.

A service refers to, for example, nursing, white an exterminating, cooking, washing, cleaning, and field work of cleaning quilts, carpets, etc.” In other words, the passage discloses that a settlement of funds is performed once a confirmation is received that an object item has been executed, and goes on to give examples of what kinds of services may comprise the object. There is no disclosure in this passage, or in the remainder of Mori, that redemption information may include information about a plurality of retailers. The plurality of retailers listed are merely examples of what kinds of service providers may participate in the system, with no disclosure that a particular redemption information may be associated with more than one service provider. Further, the remainder of Mori makes clear that a purchaser requests a settlement of funds for a particular retailer or for a particular product, not for a plurality of retailers.

Regarding claim 14, Examiner asserts that “Mori does provide an identifier associated with the product (claim 56), and does not limit the information that can be associated with the product, therefore, Mori can include any number of identifiers including SKU’s model numbers or model names.” The fact that a reference does not preclude the inclusion of a feature is insufficient to meet the Examiner’s burden of establishing a §102 or §103 rejection. “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). To anticipate a claim, a reference must teach every element of the claim. MPEP 2131. Although this passage of the MPEP is directed to §102 rejections, it is equally applicable to §103 rejections in that “[a] 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc.” (MPEP 2141.01). Applicants again reiterate that Mori does not disclose associating more than one product identifier with a particular product, as claimed in claim 14.

Further, Applicants respectfully point out that claim 14 not only recites a plurality of product identifiers for a particular product, but that each identifier is associated with a different retailer. Mori does not teach such a feature of a single product being associated with a plurality of product identifiers, where each identifier is associated with a different retailer. Examiner has not addressed this portion of the claim feature, other than stating in a conclusory manner that Mori teaches this feature,

without providing any support for this assertion. Applicants respectfully request that Examiner do so if Examiner continues to maintain the rejection of this claim.

Regarding claims **60 and 61**, Examiner responded that he “disagrees and once again directs the applicant’s attention to column 86, lines 23 – 67 of Mori” (pg. 27 of Paper No. 15). First, Examiner did not respond to Applicants’ arguments that Woolston does not teach the claimed features. Second, although in the response to Applicants’ arguments Examiner directs Applicants to a section of Mori, in the rejection of the claims, Examiner continues to rely on Woolston as the basis of the rejection (pg. 21 of Paper No. 15). Accordingly, Applicants respectfully request that Examiner respond to Applicants arguments as to why Woolston does not teach or suggest the claimed features. Third, as discussed above in Applicants reply regarding claims 9 and 10, Mori does not disclose a penalty feature.

Regarding claims **64 and 65**, Applicants note that Examiner did not reply to Applicants’ arguments that Woolston does not teach or suggest the claimed features. Yet Examiner continues to rely on Woolston as the basis of rejection of these claims (pg. 21 of Paper No. 15). Accordingly, Applicants respectfully request that Examiner respond to Applicants’ arguments regarding claims **64 and 65** if Examiner continues this rejection of the claims.

CONCLUSION

For the foregoing reasons it is submitted that all of the claims pending after the amendments made herein are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at mfincham@walkerdigital.com.

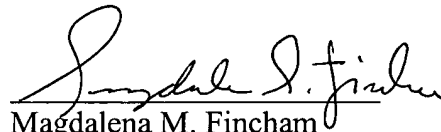
Petition for Extension of Time to Respond

Applicants hereby petition for a **one-month** extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required in addition to that requested in this petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

August 1, 2003
Date

Respectfully submitted,


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CONCLUSION

For the foregoing reasons it is submitted that all of the claims pending after the amendments made herein are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at mfincham@walkerdigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a **one-month** extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required in addition to that requested in this petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

August 1, 2003
Date

Respectfully submitted,



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